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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/792,107
Filing Date: March 03, 2004
Appellant(s): GRANDY, MICHELLE

Charlena L. Thorpe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May/30/2011 appealing from the Office action mailed April 15, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-6, 12, 15-16, 19-22 and 27-31 are pending and stand rejected in the application.

Claims 7-11, 13-14, 17-18 and 23-26 are withdrawn based on an election of species.

(4) Status of Amendments after Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,377,941	Har et al.	01-1995
5,020,751	Larkin	06-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 12, 15-16, 19-22 and 27-31 are rejected under 35 U.S.C. 102 (b)

as being anticipated by U.S. Patent number 5,377,941 to Hat et al.

As to claim 1, Hat et al. discloses a support frame for sink waste bags comprising a holder (26, 22, 50) (Fig. 1 for example) and a cover (32) attached to the holder wherein the cover is sized and positioned on the holder to conceal the storage unit (27) from being viewed in a first direction (top view direction).

As to claim 2, wherein the holder comprises a plate (50) for attaching to the surface (side wall, 36, 38); a ring piece (26) adapted to be attached to the plate that receives the storage unit (27) and holds the storage unit in place; and a first mounting piece (48, 46) (Fig. 1A, 1B) attached to the ring piece (by the hinge blocks 56, 58.).

As to claim 3, wherein any combination of the plate, the ring piece and the first mounting piece are detachable or capable of detaching.

As to claims 4 and 16, wherein the cover (32) comprises a second mounting piece (68, 70) (See Fig. 1 D) connected to the first mounting piece (46, 48) (by hinge blocks 64, 66)

As to claim 5, wherein the second mounting piece is detachable or capable of detaching from the first mounting piece.

As to claim 6, wherein the second mounting piece 68, 70 is detachable or capable of detaching from the cover 32.

As to claim 12, means (50, 52) for securing a storage unit to a surface; means (cover 32) for concealing.

As to claim 15, wherein the first direction is directed toward a front elevation (the examiner chooses the direction above the cover is a first direction).

As to claims 19-22, claims 19-22 recited limitations similar to those recite in claims 1 and 15 therefore also read on Har et al.

As to claims 27-28, claims 27-28 are similar to those recited in claims 1 and 15, respectively, therefore also met by Har et al.

As to claims 29-30, a holder (26, 22, 50) that includes a first section (50) structured to attach to a wall (36, 38), a second section (26) structured to support a waste basket (27) above a floor adjacent to the wall; and a third section (blocks 64, 66) structured to connect to a concealing cover 32 at 68, 70; a cover 32 connected to the third section 64, 66 of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket 27 supported by the holder and wherein the cover 32 is connected to the third section 64, 66 of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one

As to claim 31, further comprising a wastebasket (2) connected to the second section of the holder.

Claims 1-6, 12, 15-1 6, 1 9-22 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent number 5,020,751 to Larkin.

As to claim 1, Larkin discloses a garbage bag and utility holder comprising

a holder (14, 16, 18) (Fig. 1) and a cover (32) attached to the holder wherein the cover is sized and positioned on the holder to conceal the storage unit (27) from being viewed in a first direction.

As to claim 2, wherein the holder comprises a plate (60,) that attaches to the surface (side wall); a ring piece (14, 18) attached to the plate that receives the storage unit (50) and holds the storage unit in place; and a first mounting piece (42) (Fig. 1) attached to the ring piece.

As to claim 3, wherein any combination of the plate, the ring piece and the first mounting piece is detachable.

As to claim 4, wherein the cover (32) comprises a second mounting piece (36) (see Fig. 1) connected to the first mounting piece (42) (connected to 18 where 18 connected to 42 is therefore connect to 42).

As to claim 5, wherein the second mounting piece is detachable from the first mounting piece.

As to claim 6, wherein the second mounting piece (40) (nut) is detachable from the cover.

As to claim 12, means (60, 42, 14) for securing a storage unit to a surface; means (cover 32) for concealing.

As to claim 15, wherein the first direction is directed toward a front elevation (the examiner chooses the direction above the cover is a first direction).

As to claim 16, further comprising a second mounting piece (36) structured to attach to the cover and the first mounting piece (42).

As to claims 19-22, claims 19-22 recited limitations similar to those recite in claims 1 and 15 therefore also read on Larkin.

As to claims 27-28, claims 27-28 are similar to those recited in claims 1 and 15, therefore also read on Larkin.

As to claims 29-30, a holder (fig. 1) that includes a first section (60) structured to attach to a wall (58), a second section (14, 18, 42) structured to support a waste basket (50) above a floor adjacent to the wall; and a third section (36) structured to connect to a concealing cover 32; and a cover 32 connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket 50 supported by the holder and wherein the cover 32 is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction; wherein the at least one direction is directed toward a front elevation (direction at the elevation above the cover).

As to claim 31, further comprising a wastebasket (2) connected to the second section (14, 18, 42) of the holder.

(10) Response to Argument

First, with respect to Appellant's arguments on claim 2 (Brief, pages 6-10):

Appellant appears not satisfied with the suggestion of the claim 2 on the Final action of 4/15/2009 and stated that "Applicant does not understand why further clarification is needed and why the Examiner continues to reject or object to claim 2 without any support from federal case law, the MPEP, the CFR, or any other authority..." (Brief, page 10, 3rd paragraphs).

The following will explain why the Examiner has raised the concern/suggestion although the rejection of 112 2nd paragraphs has been withdrawn in the Final Action of 4/15/2009 and the Appellant has been clarified on the reply of 12/31/2008 that "the surface" is not part of the claim:

(a) Claims 1-2 (or even claim 29 not mentioned in the final action) are failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is inconsistency between the language in the preamble 1 and certain portions in the body of the claim 2, thereby making the scope of the claim unclear. Either Applicant claims the apparatus alone (see the preamble of claim 1,) or the combination of the apparatus and the surface, and the language of the claims be consistent with the intent. Applicant's clarification that "the surface is not a positive part of the claims. However, the preamble of the claim 1 has not been consistent with the body. Therefore, the examiner respectfully submits that the suggestion on the Final Action after Applicant's clarification is still proper as stated in the final action.

(b) The claims 1-2 and 29 are still unclear because the claims are not sufficiently precise to provide persons of ordinary skill with an accurate determination of the metes and bounds of protection involved. It is not known whether a combination or subcombination is being claimed in claims 1-2 or even claim 29 because the preamble of the independent claim 1 implies that an apparatus only a subcombination is being claimed while the body of claim 2 positively includes the combination of an apparatus and a surface or at a minimum a method of using the subcombination. The positively included elements are "a plate that attaches to the surface" "the plate that receives the storage unit and holds the storage unit in place". Similar analysis to claim 29 (claim 29 recites that "a cover connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction). In other words, It is not known whether a combination or subcombination is being claimed because the surface, the storage unit and/or wastebasket are first inferred as intended use (see preamble of claim 1 and claim 29) and then positively recited as a part of the structure combination and/or positively requires the associated structure of the combination. Because the claim recitations require the surface and the storage unit to be on the structure of the combination (attaches, receives, holds) (claim 2) and (compare dimension to the wastebasket (which is not positively claimed) (claim 29)) or at a minimum are defined

by structure that appellant has argued is not claimed, the inclusion of such recitations make the metes and bounds of the claims indefinite.

(c) While appellant has consistently argued that the scope of the claims is drawn to the subcombination, the claims clearly do not reflect this and appellant could have easily remedied the ambiguity of the claims by removing the ambiguity such that the claims were clearly drawn to the subcombination. While an art rejection was made in the office action of October 03, 2008 and April 4, 15, 2009 clearly indicates that there is no art rejection based on claims being drawn to the combination. Thus the language as claimed is clearly directed to a combination or a method of using the subcombination in the environment of the combination and not directed solely to the subcombination.

It should be noted that in the initial office action and each subsequent action, the examiner has raised a question of clarity as to whether the combination or subcombination is being claimed and made a rejection under 35 U.S.C. 112. The language of the claim must be made consistent with the appellant's intent. Appellant, however, has not amended the claims to make the claims consistent with the intent to claim the subcombination, but instead argues that "the claims are directed to the plate, ring piece and cover (apparatus) that are defined in terms of attributes they possess and in terms of their functional interrelationship with the surface, the storage unit and wastebasket when the plate, ring piece, and cover are used in their intended manner, rather than positively reciting the surface, storage unit, and wastebasket" (Brief, page 9, Paragraphs 4 & 5).

The examiner cannot agree with this position since the claims must be analyzed for what the words actually say and their context with the rest of the words in the claim. The examiner maintains that the claim interpretation that would be given by one having ordinary skill in the pertinent art at the time the invention was made would not be able to ascertain whether the claims were drawn to the subcombination and would have to speculate as to whether the claims were drawn to the combination or the subcombination and its method of use.

Second, the case law is not dispositive to the issue of the current application. Under the requirements set forth for claims under 35 U.S.C. 112, 2d, the examiner must determine during examination whether the claims particularly point out and distinctly define the meets and bounds of the subject matter that will be protected by the patent grant, whether or not the claims are clear, correct, and unambiguous, and/or whether the claim meets the threshold requirements of clarity and precision. In the instant case, the language as recited in claims 1, 2, or even claim 29 have raised the question of as to the scope of the claims and therefore the claims are not sufficiently precise to provide competitors with an accurate determination of the "metes and bounds" of protection involved. Thus the claims have failed to particularly point out and distinctly define the meets and bounds of the subject matter that Appellant regards as their invention. When claims do not particularly point out and distinctly claim that which Appellant regards as his invention, the rejection of claims under 35 U.S.C 112, second paragraph or at least an objection is appropriate. In *re Zletz*, 893 F.2d 319, 13 USPQ 2d 1320 (Fed. Cir. 1989). See also *IPXL Holdings, L.L.C.v. Amazon.com, Inc.*

In view of the reasons given above, the examiner submits that a rejection under 35 U.S.C. 112, second paragraph or an objection raised in the office action is proper and appropriate, such a rejection or objection should be made and included in the Office action.

Argument with 102(b) Rejection on Har:

Appellant submitted that the rejection of claims **1, 19, 20, 21, 22, 27, 28, 29, 30 and 12** should be reversed by the Board as based upon Har et al. failing to teach or suggest features required by above claims. The Examiner disagrees. It is clearly that Har et al discloses all of the limitations of the claimed invention as claimed in the above claims as discussed below.

As to claims 1 and 19, as discussed in the final action above, Har et al. clearly discloses a holder (26, 22, 50) (Fig. 1 for example) and a cover (32) attached to the holder wherein the cover is sized and positioned on the holder to conceal the storage unit (27) from being viewed in a first direction (from at least being viewed from at least one direction which is from top view direction).

As to claim 20, as discussed in the final action above, claim 20 also met by Hal et al. where the first direction is directed toward a front elevation (the examiner considers the first direction is directed toward above the cover is a front elevation since the first direction depends on viewer's location only).

As to claim 21, As discussed in the final action above, claim 21 also met by Har et al wherein the cover is sized and positioned on the holder to conceal the storage unit (27) and the holder from being viewed in a first direction.

As to claim 22, As discussed in the final action similar above in claim 20, claim 22 also met by Har et al wherein the first direction is directed toward a front elevation (the examiner considers the first direction is directed toward and above the cover is a front elevation since the first direction depends on viewer's location only).

As to claim 27, as discussed above in the final action, claim 27 also met by Har et al. Har et al. discloses an apparatus comprising a holder structured (22) to be secured to a surface and structured to hold a container into which matter can be deposited or removed; and a cover (32) connected to the holder that is structural and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.

As to claim 28, as discussed above in the final action, claim 28 is similar to claim 20, also met by Har et al.

As to claims 29-30, as discussed above in the final action, claim 29-30 also met by Har et al. Har et al. teaches a holder (fig. 1) that includes a first section (60) structured to attach to a wall (58), a second section (14, 18, 42) structured to

support a waste basket (50) above a floor adjacent to the wall; and a third section (36) structured to connect to a concealing cover 32; and a cover 32 connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket 50 supported by the holder and wherein the cover 32 is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction; wherein the at least one direction is directed toward a front elevation (direction at the elevation above the cover); and wherein a wastebasket (2) connected to the second section (14, 18, 42) of the holder.

As to claim 12, as discussed in the above final action, Har et al. teaches means (60, 42, 14) for securing a storage unit to a surface; and means (cover 32) for concealing in whole or in part means for hanging securing.

Arguments with 102(b) on Larkin.

Appellant submitted that the rejection of claims **1, 19, 20, 21, 22, 27, 28, 29, 30, 4, 16, 12** should be reversed by the Board as based upon Larkin failing to teach or suggest features required by above claims. This argument is not persuasive, the examiner also disagrees. It is clearly that Larkin discloses all of the limitations of the claimed invention as claimed in the above claims as discussed below:

As to claims 1 and 19 and 21 as discussed in the final action above, it is clear that Larkin discloses a holder (14, 16, 18) (Fig. 1 for example) and a cover (32) attached to the holder wherein the cover is sized and positioned on the holder to conceal in part the storage unit (27) from being viewed in a first direction (top view direction).

As to claim 20, as discussed in the final action above, claim 20 also met by Larkin where the first direction is directed toward a front elevation (the examiner considers the first direction is directed toward above the cover is a front elevation since the first direction depends on viewer's location only).

As to claim 22, As discussed in the final action similar above in claim 20, claim 22 also met by Larkin wherein the first direction is directed toward a front elevation (the examiner considers the first direction is directed toward and above the cover is a front elevation since the first direction depends on viewer's location only).

As to claim 27, as discussed above in the final action, claim 27 also met by Larkin. Larkin discloses an apparatus comprising a holder (14, 16, 18) (for example) structured to be secured to a surface and structured to hold a container into which matter can be deposited or removed; and a cover (32) connected to the holder that is structural and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.

As to claim 28, as discussed above in the final action, claim 28 is similar to claim 20, also met by Larkin

As to claims 29-30, as discussed above in the final action, claims 29 -30 also met by Larkin. Larkin teaches a holder (fig. 1) that includes a first section (60) structured to attach to a wall (58), a second section (14, 18, 42) structured to support a waste basket (50) above a floor adjacent to the wall; and a third section (36) structured to connect to a concealing cover 32; and a cover 32 connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket 50 supported by the holder and wherein the cover 32 is connected to the third section of the holder in an orientation that hides the at least one surface seen from at least one direction; wherein the at least one direction is directed toward a front elevation (direction at the elevation above the cover); and wherein a wastebasket (2) connected to the second section (14, 18, 42) of the holder.

As to claim 4, as discussed above in the final action, claim 4 also met by Larkin, wherein the cover (32) comprises a second mounting piece (36) (see Fig.1) connected to the first mounting piece (42) (connected to 18 where 18 connected to 42 is therefore connect to 42).

As to claim 16, further comprising a second mounting piece (36) structured to attach to the cover and the first mounting piece (42).

As to claim 12, as discussed above in the final action, claim 12 also met by Larkin wherein means (60, 42, 14) for securing a storage unit to a surface; and means (cover 32) for concealing in part means for hanging securing.

It should be noted throughout the Briefs, Appellant's arguments appeared repeatedly contended that element 32 of Har and element 32 of Larkin is a top lid not a cover and element 32 of both Har and Larkin is not sized to conceal a "storage unit" as recited in claims 1, 12, 27 and 29. Appellant's same argument for element 27, 30 of Har and/or element 50 of Larkin is a large central opening, not a "storage unit" or "a container". Har or Larkin does not need to use appellant's lexicography such as "a cover" or "storage unit" or "a container" to anticipate appellant's claims. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "read on" something disclosed in the reference, i.e., all limitations of the claim are found in reference, or are "fully met" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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